

Attorney Docket No. 000213

## REMARKS

### 1. Claim Amendments

Applicants have amended claims 1, 4, 6 and 8 to better claim the invention and added claims 10-15 to further claim the invention. Support for the amendments can be found, for example, on page 7, lines 26-34, page 8, lines 12-24 and page 9 of the present patent application. Accordingly, claims 1-15 are pending in the present patent application. Favorable reconsideration of the application is respectfully requested in view of the foregoing amendments and the following remarks.

### 2. Claim Rejections – 35 U.S.C. § 102

Claims 1-9 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,349,224 issued to Lim (hereinafter "Lim"). To support such rejection, Lim must disclose every element of the invention as claimed. More particularly, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). With the above requirement in mind, Applicants respectfully submit that Lim fails to disclose every element of the invention as specified in each amended independent claim.

Regarding claim 1, Applicants respectfully submit that Lim fails to teach or suggest at least one element specified in claim 1. For example, Lim fails to teach or suggest the element regarding "*determining if said second wireless communication device is operating within said*

wireless communication system by using the identification code". Such identification code is determined based on the initial communication from the first device.

Turning to the Office Action, the Examiner indicates that Lim discloses the determination of this identification code by citing column 4, lines 46-49. *Office Action, page 4*. This cited section of Lim certainly does reference a receiver identification number ID that is transmitted from an originating base station (BS-O) to a mobile switching center (MSC). Thereafter, the MSC forwards such receiver identification number ID to a terminating base station (BS-T) so that an eventual communication between originating and terminating mobile data terminals (TE2-O and TE2-T) respectively associated with the BS-O and BS-T can be established. *Lim, Figure 4*.

Assuming *arguendo* that the receiver identification number ID of Lim is similar to the identification code specified by claim 1, Lim still fails to teach or suggest the element regarding "determining if said second wireless communication device is operating within said wireless communication system by using the identification code". Regarding this element, the Examiner relies on column 4, lines 50-66 of Lim for disclosing it. This reliance is **not correct**. As discussed above, Lim discloses the transmission of this receiver identification number ID from the BS-O to the MSC, which in turn forwards it to the BS-T for establishing a communication supported by BS-O and BS-T. Lim simply does **not** discuss, teach or suggest how such receiver identification number ID could be used to determine if the second wireless communication device (TE2-T) is operating within the same wireless communication system.

Accordingly, claim 1 is not anticipated by and is believed to be patentably distinguishable over Lim.

Claims 2-3 depend from independent claim 1, which is believed to be patentable, and thus their rejection is moot.

Independent claim 4 comprises at least one limitation that is similar to at least one limitation of claim 1, which is believed to be patentable. Accordingly, claim 4 is not anticipated by and is believed to be patentably distinguishable over Lim for reasons similar to those discussed above regarding claim 1.

Claim 5 depends from independent claim 4, which is believed to be patentable, and thus its rejection is moot.

Independent claim 6 comprises at least one limitation that is similar to at least one limitation of claim 1, which is believed to be patentable. Accordingly, claim 6 is not anticipated by and is believed to be patentably distinguishable over Lim for reasons similar to those discussed above regarding claim 1.

Claim 7 depends from independent claim 6, which is believed to be patentable, and thus its rejection is moot.

Independent claim 8 comprises at least one limitation that is similar to at least one limitation of claim 1, which is believed to be patentable. Accordingly, claim 8 is not anticipated by and is believed to be patentably distinguishable over Lim for reasons similar to those discussed above regarding claim 1.

Claim 9 depends from independent claim 8, which is believed to be patentable, and thus its rejection is moot.

### **3. Claim Rejections – 35 U.S.C. § 103**

Claims 1-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lim in view of Applicants' admitted prior art (hereinafter "APA"). Before addressing this rejection in detail, it should be noted that the Examiner bears the initial burden of factually supporting any

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*prima facie* conclusion of obviousness. *MPEP 2142*. To establish *prima facie* case of obviousness, certain criteria must be met. *First*, the prior art reference or references when combined must teach or suggest all the claim limitations. *Second*, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. With the above requirements in mind, Applicants respectfully traverse this rejection as it applies to each amended independent claim per discussion below.

Regarding the amended independent claim 1, Applicants respectfully submits that it should be non-obvious and patentably distinguishable over Lim in view of APA for reasons similar to those discussed above with respect to the rejection of claim 1 under 35 U.S.C. § 102. .

Regarding claims 2-3, they depend from independent claim 1, which is believed to be patentable, and thus they should also be non-obvious and patentably distinguishable over the cited prior art references. *MPEP 2143.03*.

Regarding independent claim 4, it comprises at least one limitation that is similar to at least one limitation of claim 1, which is believed to be patentable. Accordingly, claim 4 should be non-obvious and patentably distinguishable over the cited prior art references for reasons similar to those discussed above regarding claim 1.

Regarding claim 5, it depends from independent claim 4, which is believed to be patentable, and thus it should also be non-obvious and patentably distinguishable over the cited prior art references. *MPEP 2143.03*.

Regarding independent claim 6, it comprises at least one limitation that is similar to at least one limitation of claim 1, which is believed to be patentable. Accordingly, claim 6 should be non-obvious and patentably distinguishable over the cited prior art references for reasons similar to those discussed above regarding claim 1.

Regarding claim 7, it depends from independent claim 6, which is believed to be patentable, and thus it should also be non-obvious and patentably distinguishable over the cited prior art references. *MPEP 2143.03*.

Regarding independent claim 8, it comprises at least one limitation that is similar to at least one limitation of claim 1, which is believed to be patentable. Accordingly, claim 8 should

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be non-obvious and patentably distinguishable over the cited prior art references for reasons similar to those discussed above regarding claim 1.

Regarding claim 9, it depends from independent claim 8, which is believed to be patentable, and thus it should also be non-obvious and patentably distinguishable over the cited prior art references. *MPEP 2143.03*.

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**CONCLUSION**

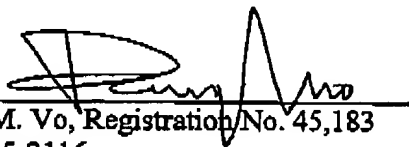
Claims 1-15 are presently standing in this patent application. In view of the foregoing remarks, each and every point raised in the Office Action mailed on March 20, 2006 has been addressed on the basis of the above remarks. Applicants believe all of the claims currently pending in this patent application to be in a condition for allowance. Reconsideration and withdrawal of the rejections are respectfully requested. However, should the Examiner believe that direct contact with Applicants' attorney would advance the prosecution of the application, the Examiner is invited to telephone the undersigned at the number given below.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

Dated: September 20, 2006

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